

## **REMARKS/ARGUMENTS**

Applicants have received and carefully reviewed the Office Action of the Examiner mailed October 20, 2008. Currently, claims 35-46, 49, and 51-57 remain pending and claims 35-46, 49, and 51-57 have been rejected. After careful review, Applicants traverse the rejection of claims 35-46, 49, and 51-57. In this amendment, the specification and claims 35 and 52 have been amended, and new drawings provided. Support for the claim amendments is disclosed by the specification - for example, in paragraph [0042] of the published application (US 2002/0072717). No new material has been added. Favorable consideration of the above amendments and the following remarks is respectfully requested.

### ***Drawing Objections***

The Examiner has objected to the drawings under 37 CFR 1.83(a). The Examiner asserts that the drawings do not show every feature of the invention specified in the claims. New drawings are provided with this amendment pursuant to 37 CFR 1.121(d). Applicants submit that the new drawings satisfy the Examiner's objection.

### ***Claim Rejections - 35 USC § 102***

Claims 35-42, 44, 49, 51-52 and 55-57 stand rejected under 35 U.S.C. §102(e) as being anticipated by Ellis et al. (U.S. Patent No. 6,416,490). Applicants respectfully traverse the rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (MPEP 2131).

The Examiner asserts that Ellis et al. disclose "at least a portion of the lumen is configured to receive the therapeutic substance, and wherein at least a portion of the at least one injury effector passes through, and is electrically isolated from (by insulators 24 and 26), the portion of the lumen configured to receive the therapeutic substance". However, in making the rejection, the Examiner has failed to identify exactly what is being considered to be the claimed lumen. Reference numeral 30 is disclosed by Ellis et al. to be a lumen (and asserted by the Examiner to be the therapeutic substance delivery effector), but the injury effector (asserted by

Examiner to be electrode 23) clearly does not pass through this lumen. The other potential lumen identified by the Applicants is occupied by stop 28, and is actually formed by electrode 23 and insulators 24 and 26. Consequently, electrode 23 cannot pass through the lumen. Clearly this aspect of independent claims 35 and 52 does not appear to be disclosed by Ellis et al.

Additionally, Ellis et al. discloses in column 4, lines 25-29:

“FIG. 4 is a perspective, partial cross-sectional view of catheter 20 modified to include a hypotube or needle 36 extending distally from lumen 30. The distal end of hypotube 36 includes a sharpened end 38, and a lumen defined therethrough in fluid communication with lumen 30.”

It appears that when hypotube 36 is present, it is disposed within lumen 30 and in fluid communication with lumen 30. This would seem to preclude the Examiner's assertion that these are separate structures (Office Action page 4, lines 6-7). It also appears that with this relationship, they (lumen 30 and hypotube 36 – the asserted marking effector and therapeutic-substance delivery effector) will both act upon the same tissue location, rather than the claimed second and third tissue locations.

Since it appears that Ellis et al. do not disclose each and every element of independent claims 35 and 52, Ellis et al. cannot anticipate these claims. Therefore claims 36-42, 44, 49, 51 and 55-57, which depend from claims 35 or 52, and add additional elements thereto, are also not anticipated by Ellis et al. Applicants respectfully request that the rejection be withdrawn.

Claims 35-42, 44-45, 49, 51-52 and 54-57 stand rejected under 35 U.S.C. §102(e) as being anticipated by Negus et al. (U.S. Patent No. 6,902,562). Applicants respectfully traverse the rejection.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (MPEP 2131).

In response to Applicants' previous argument, the Examiner asserts that “Negus discloses that the lumen (lumen of 12) is designed to hold within it the therapeutic catheter (208) and the injury effector (13). Therefore, the lumen of (12) can be interpreted as receiving the therapeutic substance”. With this amendment, claims 35 and 52 are amended to add the limitation “wherein the lumen is in substance communication with the therapeutic substance delivery effector”.

Clearly, this is not the case in Negus et al. It appears that therapeutic catheter 208 (connected to syringe 204) is held entirely within lumen 12, but does not have substance communication with lumen 12 such that a substance in lumen 12 will be able to communicate with the therapeutic substance delivery effector.

Since it appears that Negus et al. do not disclose each and every element of independent claims 35 and 52, Negus et al. cannot anticipate these claims. Therefore claims 36-42, 44-45, 49, 51 and 54-57, which depend from claim 35 or 52, and add additional elements thereto, are also not anticipated by Negus et al. Applicants respectfully request that the rejection be withdrawn.

### ***Claim Rejections - 35 USC § 103***

Claims 43 and 53 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ellis et al. or Negus et al. in view of Daniel et al. (U.S. Patent No.6,174,307). Claims 45 and 54 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ellis et al. Claim 46 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Negus et al. Applicants respectfully traverse the rejections.

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (MPEP 2143.03).

As discussed above, independent claims 35 and 52 are believed to be patentable over Ellis et al. and Negus et al. Claims 43, 45, 46, 53, and 54 depend from claim 35 or 52 and add additional elements thereto. Daniel et al. do not appear to remedy the deficiencies of Ellis et al. or Negus et al. In view of the discussion above, Applicants submit that claims 43, 45, 46, 53, and 54 are patentable over the cited references and respectfully request that the rejection be withdrawn.

***Conclusion***

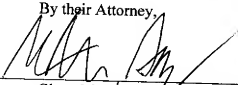
In view of the foregoing, all currently pending claims are believed to be in condition for allowance. Reexamination and reconsideration are respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By their Attorney,

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